

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

100051.11211 (WAL_SCO.007)

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Signature _____

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Application Number

10/611533

Filed

June 30, 2003

First Named Inventor

Scott A. Waldman

Art Unit

1642

Examiner

Misook Yu

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

Daniel M. Soolnick, Reg. No. 52,201

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Daniel M. Soolnick

Typed or printed name

☒ attorney or agent of record.
Registration number 52,201

610.640.7820

Telephone number

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

November 12, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
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9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

DOCKET NO. 100051.11211
PATENT

SERIAL NO. 10/611,533
FILED: June 30, 2003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Scott A. Waldman *et al.*

Confirmation No: 4518

Serial No.: 10/611,533

Group Art Unit: 1642

Filed: June 30, 2003

Examiner: Misook Yu

Title: **COMPOSITIONS AND METHODS FOR IDENTIFYING AND
TARGETING CANCER CELLS OF ALIMENTARY CANAL ORIGIN**

VIA EFS WEB

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P.O. Box 1450
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

This response is being filed in response to the outstanding Final Official Action dated May 12, 2009 and the Advisory Action, dated August 27, 2009 in connection with the above-identified patent application. Applicants enclose herewith a Pre-Appeal Brief Request for Review, a Notice of Appeal, a petition for extension of time and payment of the appropriate fee. In response to the Final Rejection and the Advisory Action, Applicants respectfully request reconsideration of the pending rejections in view of Applicants Supplemental Response filed September 14, 2009 and the present request herein. Applicants respectfully request entry of the

amendments filed on September 14, 2009 and withdrawal of the pending rejections upon reconsideration.

REMARKS

Applicants filed a Supplemental response on September 14, 2009 in view of the Advisory Action mailed August 27, 2009. The supplemental response amended the claims to recite that the methods claimed therein "consist of" of the recited step. Upon entry of the amendment, claims 29-31, 39 and 46-54 are in allowable condition. As of November 12, 2009 the Office has not yet responded to the supplemental response. Accordingly, Applicants have submitted the present pre-appeal brief conference request in view of the statutory six month deadline.

Claim Rejection Under 35 U.S.C. § 103

Claims 29-31, 39, 47-51, 53 and 54 stand rejected under 35 U.S.C. § 103 as being unpatentable over Silberg in view of US Patent No. 5,601,990 or over Silberg in view of US Patent No. 5,601,990 and further in view of Genbank Accession no. U51095.

The Office asserted that because "Silberg teaches the 'possibility' of CDX1 being a marker" and the open term of "comprising" does not exclude other steps or tests for diagnosis in addition to CDX1" the subject matter of claims 29-31, 39, 47-51, 53 and 54 are obvious. The pending claims recite the more restricted phrase "consisting of." The combination of the references fail to render the presently claimed invention obvious. Accordingly, as amended to the rejection is obviated.

Applicants respectfully request that the rejections of claims 29-31, 39, 47-51, 53 and 54 be withdrawn.

Withdrawal of Claims

Claims 46 and 52 have been withdrawn. No reason is provided for the withdrawal of the claims but it is presumed that in view of the earlier amendment, claims 46 and 52 are redundant..

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Applicants respectfully note that upon entry of the amendment of claims 29 and 49, claims 46 and 52 will differ in scope from each of claims 1-3, 8-13, 19, 20, 55-57, 60 and 61. Accordingly, reconsideration is proper and hereby requested.

Conclusion

Claims 1-3, 8-13, 19, 20, 29-31, 39, 46-57, 60 and 61 are in condition for allowance. A notice of allowance is earnestly solicited. Applicants invite the Examiner to contact the undersigned at 610.640.7820 to clarify any unresolved issues raised by this response.

The Commissioner is hereby authorized to charge any deficiencies of fees and credit of any overpayments to Deposit Account No. 50-0436.

Respectfully submitted,

/Daniel M. Scolnick, 52.201/
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Dated: November 12, 2009
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